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Patent
Case No.: 54135US011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: BOWERS, JOHN L.
Application No.: 09/986346 Group Art Unit: 3753
Filed: November 8, 2001 Examiner: John A. Rivell
Title: UNI-DIRECTIONAL FLUID VALVE

COMMUNICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<p>CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR § 1.8(a))</p> <p>I hereby certify that this correspondence is being:</p> <p><input type="checkbox"/> deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p><input checked="" type="checkbox"/> transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.</p> <p>December 14, 2004 Date</p> <p><i>Susan M. Dacko</i> Signed by: Susan M. Dacko</p>

Dear Sir:

This Communication is being filed to place on record the litigation that is pending between the 3M Company, the 3M Innovative Properties Company, and Moldex-Metric, Inc. The 3M Innovative Properties Company is a wholly-owned subsidiary of the 3M Company and holds its intellectual property. Both entities are located in St. Paul, Minnesota and are referred to collectively hereafter as "3M".

On September 24, 2003, 3M filed a patent infringement lawsuit against Moldex-Metric, Inc. of Culver City, California. The patent infringement lawsuit is pending in the District Court of Minnesota under Civil Action No. 03/5292. In its Answer to the 3M Complaint, Moldex-Metric has alleged that 3M's U.S. Patent RE 37,974 is invalid under 35 USC § 102 and/or 35 USC § 103. As the Examiner is aware, issued patent RE 37,974 is a parent application to this present continuation application.

Moldex-Metric has told 3M that it has evidence of a valve conception that invalidates U.S. Patent RE 37,974. Moldex-Metric has stated that this evidence is corroborated by a drawing that is dated a few days prior to the effective filing date of the present application. 3M has not been supplied a copy of this Moldex valve document, and the date of the drawing is subject to a an agreement of confidentiality between outside counsel, pending entrance of a protective order.

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Accordingly, 3M does not have further facts that it can present to the United States Patent (USPTO) and Trademark Office at this time.

If and when 3M obtains any actual evidence that supports the Moldex-Metric position of invalidity and that evidence can be furnished to the USPTO without violating a protective order, it will be forwarded to the USPTO for consideration in light of the presently-claimed subject matter. Under the facts as 3M presently understands them, however, 3M believes that the presently-claimed valve was, in any case, reduced to practice in the United States before Moldex-Metric's alleged earliest invention date. The valve product for which Moldex-Metric asserts that it has an earlier invention date is shown in U.S. Patent 6,047,698 to Magidson. As the Examiner will notice, the Magidson patent has a filing date of August 20, 1998, which is more than three years after the effective filing date of this case, August 4, 1995.

Applicant also brings the allowance of other 3M valve-related patent applications to the Examiner's attention. U.S. Patent Application Serial Nos. 08/240,877, 09/677,637, 09/678,579, and 09/837,800 have been allowed. The issue fees in these cases have all been paid. U.S. Patent Applications 09/678,580, 09/680,465, and 09/837,714 are still pending. All of these valve cases are continuations or divisionals of the Japuntich et al. series (see U.S. Patents 5,509,436 and 5,325,892).

Respectfully submitted,

December 14, 2004
Date

By: 
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Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833

FACSIMILE TRANSMITTAL FORM	Application Number	09/886346
	Filing Date	November 8, 2001
	First Named Inventor	Bowers, John L.
	Art Unit	3753
	Examiner Name	John A. Rivell
Fax: 703-872-9308	Attorney Docket Number	54135US011
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Date: December 14, 2004		Attorney for Applicant: Karl G. Hanson

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<input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/Declaration(s)	<input type="checkbox"/> Petition to Convert a Provisional Application	<input type="checkbox"/> Appeal Communication to Technology Center (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Proprietary Information
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